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| 09/325,040 | 06/07/1999 | JON A. BREWSTER | 10991693-1 | 2318 |

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| EXAMINER |
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MYHRE, JAMES W

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| ART UNIT | PAPER NUMBER |
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3622

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/325,040

Applicant(s)
Brewster et al

Examiner
James W. Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 26, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-85 is/are pending in the application.
- 4a) Of the above, claim(s) 23-32 and 49-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22, 33-48, and 77-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. The amendment filed on November 26, 2003 under 37 CFR 1.111 has been considered but is ineffective to overcome the Griebenow et al (5,850,520), Austin (6,157,924), and Logan et al (5,721,827) references.

The amendment amended Claims 1, 3, and 15 and added new Claims 77-85. Claims 23-32 and 49-76. Therefore, the claims under current consideration are Claims 1-22, 33-48, and 77-85.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 12-15, 33, and 77-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griebenow et al (5,850,520) in view of Austin (6,157,924).

Claim 1: Griebenow discloses a method for automatically printing a document, comprising:

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a. Storing a print schedule with an indication that the document should be printed at a user requested time (e.g. monthly)(col 4, lines 25-31 and col 8, lines 19-33);

b. Automatically requesting and receiving the document without user intervention (col 4, lines 32-45 and col 8, lines 19-33).

Griebenow discloses the document being automatically sent to the user's computer or to a predetermined location and that the user's computer includes a printer (col 3, lines 25-34), but does not explicitly disclose that the document will also be automatically printed on the user's printing device. Austin discloses a similar method for automatically delivering information using "Push" technology (col 10, lines 45-54) to a user in which the method of delivery (e.g. print) and frequency of delivery (e.g. monthly)(See Figure 4A) is chosen by the user and stored in the user profile. When the desired information is to be retrieved and sent to the user, it is formatted into the desired format; explicitly "If a determination is made that the delivery medium is to be printed copy (Block 160), the retrieved information, and any additional information, is formatted as a printed copy (Block 162). The printed copy is then delivered to a user's printer (Block 164)" (col 13, lines 35-39). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to automatically send the document in Griebenow to the user's printer if the user had indicated his desire to receive a printed copy. One would have been motivated to send the document directly to the printer in order to deliver the document in the preferred medium and to eliminate the need for the user to perform the tedious steps of downloading each file, opening each file, and selecting the print button to manually print each file.

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Claim 2: Griebenow and Austin disclose a method for automatically printing a document as in Claim 1 above, and Griebenow further discloses storing a user profile (col 6, lines 65-67).

Claims 3, 77, and 78: Griebenow and Austin disclose a method for automatically printing a document as in Claim 2 above, and Griebenow further discloses updating the user profile to reflect the delivery (printing) of the document (using a return receipt)(col 7, lines 10-55). Furthermore, Austin also discloses that the system will verify the successful delivery of the document to the user's printer (col 13, lines 13-17) and that this information is used to update the customer file (col 15, lines 13-23).

Claim 12: Griebenow and Austin disclose a method for automatically printing a document as in Claim 2 above, and Griebenow further discloses including advertising content in the document (col 5, lines 12-22).

Claims 13, 14, and 33: Griebenow and Austin disclose a method for automatically printing a document as in Claims 3 and 12 above, and Griebenow further discloses personalizing the advertising content and the document content based on the user profile (col 5, lines 12-22 and col 6, lines 65-67).

Claim 15: Griebenow and Austin disclose a method for automatically printing a document as in Claim 13 above, and Griebenow further discloses updating the user profile to reflect the delivery (printing) of the document (using a return receipt)(col 7, lines 10-55). Furthermore, Austin also discloses that the system will verify the successful delivery of the document to the

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user's printer (col 13, lines 13-17) and that his information is used to update the customer file (col 15, lines 13-23).

Claims 79 and 80: Griebenow and Austin disclose a method for automatically printing a document as in Claim 78 above, but do not explicitly disclose that the user requests a delivery time on a specific day of the week or month or after a specified lapse of time. However, while Griebenow gives an example of the user ordering a monthly publication, it would have been obvious that the publication could have other publication periods, such as weekly, daily, quarterly, or any other time period designated by either the publisher or the user (such as the user requesting a portfolio update from his broker every Wednesday or at 8:00 a.m. each weekday morning). One would have been motivated to delivery the requested document using other periods of time, such as the claimed day of the week or month, in order to met the needs of the user and to allow other periodicals, such as daily electronic newspapers, to participate in the Griebenow invention.

4. Claims 34-38 and 43-48 are rejected under 35 U.S.C. 103(a) as being anticipated by Logan et al (5,721,827).

Claim 34: Logan discloses a method for subsidizing printing of documents, comprising:

- a. Monitoring the usage of a printing device (col 26, lines 53-59); and
- b. Subsidizing the purchase of a product based on the monitoring step (col 26, lines 53-59).

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While Logan discloses monitoring the usage of an audio device instead of a printing device, both devices are being used to deliver a desired electronic content file to a user. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the method steps in Logan could be used to monitor any electronic information delivery device to include a printer, an audio device, a video device, a computer, or even a copier or fax machine. One would have been motivated to monitor the usage of other types of devices, such as a printer, in view of Logan's disclosure that the downloaded files could contain audio, text, or both.

Claims 35-38: Logan discloses a method for subsidizing printing of documents as in Claim 34 above, and further discloses updating a user profile with an indication that an advertisement has been printed in the document and with the amount of resources (e.g. ink, paper, etc.) that has been used to print the document (col 26, lines 53-59). Again as discussed in Claim 34 above, while Logan discloses tracking and storing (in a usage log) the costs to deliver an audio file, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the same steps could be used to determine the cost of delivering other electronic files to include the costs of printing an electronic document, such as amount of ink and/or paper used.

Claims 43-45: Logan discloses a method for subsidizing printing of documents as in Claim 34 above, and further discloses various funding sources, such as advertising and distribution revenues (col 6, lines 1-9 and col 20, lines 3-7).

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Claims 46-48: Logan discloses a method for subsidizing printing of documents as in Claim 35 above, and further discloses providing the monitored information to a third party, such as an advertiser or content provider (col 27, lines 4-27).

5. Claims 4-11, 16-22, 39-42, and 81-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griebenow et al (5,850,520) in view of Austin (6,157,924) and in further view of Logan et al (5,721,827).

Claims 4 and 16: Griebenow and Austin disclose a method for automatically printing a document as in Claims 3 and 15 above, but do not explicitly disclose subsidizing a product for a user based on updating the user profile. However, Logan discloses a similar method for delivering documents which include advertisements like Griebenow and which also discloses subsidizing a product (programs heard) based on updating the user profile (col 26, lines 53-59). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the advertising revenue discussed in Griebenow (col 6, lines 2-12) to subsidize the cost to the user for printing the document. One would have been motivated to subsidize the user's cost in this way in order to entice the customers to use the system.

Claims 5-11, 17-22, 39-42, and 81-85: Griebenow, Austin, and Logan disclose a method for automatically printing and subsidizing a document as in Claims 4, 16, and 34 above. All three references further disclose sending various types of advertising and promotional products, such as a free or discounted print consumable, printable media (e.g. coupon), or product to the user

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(Griebenow, col 10, line 58 - col 11, line 22)(Austin, col 10, lines 34-44 and 59-67)(Logan, col 24, lines 1-14). While none of the references explicitly discloses that the advertising content includes a coupon, coupons are old and well known form of advertisements and would have been an obvious choice for the advertisers in Griebenow or in Logan. One would have been motivated to present a coupon to the user in order to entice the user to buy the product by clicking on the “purchase” or “order” link discussed in each reference. The Examiner further notes that the type of product or service being offered as an incentive, whether a print consumable, a printing device, or any other type product or service (or a coupon for such) does not affect the steps of providing the incentive to the user. It is obvious that the targeted advertisement in Griebenow could be for any product or service desired by the advertiser.

Response to Arguments

6. Applicant's arguments filed November 26, 2003 have been fully considered but they are not persuasive.

A. The Applicant argues that neither Griebenow nor Austin disclose automatically printing the document on the user's printer or storing a print schedule which includes an indication of a user requested time for printing (page 11). The Examiner notes that these arguments have been fully addressed in the expanded rejection of Claims 1-3 above. The Examiner further notes that these claims have been rejected on the combination of Griebenow and Austin. Griebenow's disclosure that the user's computer includes an attached printer and

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automatically delivering a document to the user, along with Austin's disclosure of automatically sending a document to the user's printer renders it obvious to automatically print the document on the user's printer. Griebenow also discloses delivering the document to the user at a predetermined time (e.g. monthly) and that the user has selected the predetermined time by selecting a monthly publication. As discussed above, it is obvious that if the user selected a daily or weekly publication (e.g. a newspaper) the print schedule would be daily or weekly.

B. The Applicant also argues that neither Griebenow nor Austin disclose updating the user profile with an indication that the document printed successfully (page 12). The Examiner notes that this has been discussed at length in the above rejection, and that both references include verification procedures (e.g. return receipts) to verify that the document has been successfully delivered to the user device. This verification data is stored in the user's file at the server location.

C. The Applicant argues that new Claims 79 and 80 include the limitation that the user specified time is a specific day of the week or month of a lapse of a user specified time period (page 12). These features are shown by or obvious over the references as discussed in the rejection of these claims above.

D. The Applicant argues in reference to Claim 34 and new Claim 81 that the Logan reference discloses monitoring a user's audio device, but not a user's printer and that it would not have been obvious to do so without using hindsight (page 13). While it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight

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reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instance case, Logan discloses monitoring a user device to which an electronic document is being sent. Logan also discloses that text and image files may be sent to the user device, which may convert the text files into an audio file using convention speech synthesis. As discussed in the rejection of these claims above, it would have been obvious that the user device being monitored could be a printer or other known output devices normally associated with a client computer, such as a fax machine, plotter, display device, etc.

E. The Applicant argues in reference to Claims 35-38 that Logan does not disclose updating the user profile with the amount of resources used to print the document, such as indicating that document has been printed (Claim 35), that advertising in the document was printed (Claim 36), or the amount of ink used (either total ink or by color)(Claims 37 and 38, respectively)(page 13). The Examiner notes that Logan discloses maintaining a usage log which tracks the resources (program segments) used by the user. As discussed in the rejection of these claims above, it would have been obvious to monitor usage costs using the steps in Logan with any type of output device to which the electronic document was sent, such as a printer, fax machine, etc. The type of user device being monitored would dictate the type of data collected, such as the amount of paper and ink used by a printer, fax machine, or plotter; the amount of

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floppy disks or tape used by a storage device used to store the document; the amount of paper, postage, and envelopes used by a mailing system, etc.

F. The Applicant argues in reference to Claims 4-11, 16-22, and 39-42 that the three references do not disclose sending promotional products, i.e. the products themselves, to the user (page 14). The Examiner notes that the reference disclose sending targeted advertisements and promotions to the user based on the document, the user's profile data, and/or the usage log of the user device. It is also customary for advertisers to provide incentives, such as coupons or free sample products, to customers to entice them to purchase new or additional items. Furthermore, the type of targeted incentive offer being provided to the user does not affect the steps involved in generating and sending the offer to the user. Thus, it would have been obvious for an advertiser to use any or all of the information being collected by the references when targeting the incentive to the user and that the incentive could be an advertisement, a coupon, a product, or any other known type of incentive.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after


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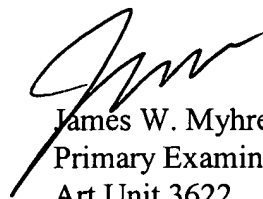
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.


JWM
January 12, 2004


James W. Myhre
Primary Examiner
Art Unit 3622